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OFFICE OF PETITIONS

In re Patent No. 7,422,743	:	
Chirica et al.	:	
Issued: September 9, 2008	:	DECISION ON REQUEST FOR
Application No. 10/720,026	:	RECONSIDERATION OF
Filed: November 21, 2003	:	PATENT TERM ADJUSTMENT
Atty Docket No.	:	
DX01074B1K	:	

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d)," filed on November 7, 2008. Patentees request that the patent term adjustment indicated on the face of the patent be corrected from 575 days to 956 days.

The request for reconsideration of patent term adjustment is **DISMISSED**.

On September 9, 2008, the above-identified application matured into US Patent No. 7,422,743 with a patent term adjustment of 575 days. This request for reconsideration of patent term adjustment (including the required fee) was timely filed within two months of the issue date of the patent. See 1.705(d).

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Patentees assert, in part, that they are entitled to additional patent term adjustment pursuant to Wyeth v. Dudas.[1] Patentees request recalculation of the patent term adjustment to include a

[1] 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008).

443 day period of adjustment pursuant to 37 C.F.R. §1.703(b). Patentees maintain entitlement to a period of adjustment due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.703(b), of 443 days and the period of adjustment due to other examination delay, pursuant to 37 CFR §1.702(a), of 613 days.

The 443 day period is calculated based on the application having been filed under 35 U.S.C. §111(a) on November 21, 2003, and a request for continued examination (RCE) having been filed in this application on February 2, 2008, three years and 443 days later. Patentees assert that in addition to this 443 day period, they are entitled to a period of adjustment due to examination delay, pursuant to 37 CFR §1.702(a), of 613 days for the failure by the Office to mail at least one of a notification under 35 U.S.C. 132 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a), pursuant to § 1.702(a)(1). A first non-final Office action was mailed on May 18, 2005, 14 months and 613 days after the application was filed on November 21, 2003.

Under 37 CFR § 1.703(f), Patentees are entitled to a period of patent term adjustment equal to the period of delays based on the grounds set forth in 37 CFR §1.702 reduced by the period of time equal to the period of time during which Patentees failed to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR §1.704. In other words, the period of Office delay reduced by the period of applicant delay. Patentees also assert that the total period of applicant delay is 100 days.[2]

Patentees do not dispute that the total period of Office delay is the sum of the period of Three Years Delay terminated by the filing of an RCE (443 days) and the period of Examination Delay (613 days) to the extent that these periods of delay are not overlapping. However, in effect, Patentees contend that no portion of the Three Year Delay period overlaps with the period of 14 month examination delay. Accordingly, Patentees submit that the total period of adjustment for Office delay is 1056 days, which is the sum of the period of Three Year Delay (443

[2] Patentees do not dispute the reduction of 2 days, pursuant to 37 CFR 1.704(b), for the filing on May 29, 2007, of a reply to the non-final Office action mailed on February 27, 2007, three (3) months and two (2) days after the mailing of the Office action, or the reduction of 36 days, pursuant to 37 CFR 1.704(c)(10), for the mailing, on July 9, 2008, of a response to an amendment after the mailing of a notice of allowance 36 days after the filing, on June 4, 2008, of the amendment after the mailing of a notice of allowance.

days) and the period of Examination Delay (613 days), reduced by the period of overlap (0 days).

As such, Patentees assert entitlement to a patent term adjustment of 956 days (443 + 613 reduced by 0 overlap - 100 (applicant delay)).

The Office agrees that as of the filing of the RCE on February 7, 2008, the application was pending 3 years and 443 days after its filing date. The Office agrees that the action detailed above was not taken within the specified time frame, and thus, the entry of a period of adjustment of 613 days is correct. At issue is whether Patentees should accrue 443 days of patent term adjustment for the Office taking in excess of three years to issue the patent, as well as 613 days for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that 443 days overlap. Patentees' calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

> to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Likewise, 37 CFR 1.703(f) provides that:

> To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C.

154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

> If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

The current wording of § 1.703(f) was revised in response to the misinterpretation of this provision by a number of Patentees. The rule was slightly revised to more closely track the corresponding language of 35 U.S.C. 154(b)(2)(A). The relevant portion differs only to the extent that the statute refers back to provisions of the statute whereas the rule refers back to sections of the rule. This was not a substantive change to the rule nor did it reflect a change of the Office's interpretation of 35 U.S.C. 154(b)(2)(A). As stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing

date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding §1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed. The grounds specified in these sections cover the A) guarantee of prompt Patent and Trademark Office responses, B) guarantee of no more than 3 year application pendency, and C) guarantee or adjustments for delays due to interference, secrecy orders and appeals. A section by section analysis of 35 U.S.C. 154(b)(2)(A) specifically provides that:

> Section 4402 imposes limitations on restoration of term. In general, pursuant to [35 U.S.C.] 154(b)(2)(A)-(C), total adjustments granted for restorations under [35 U.S.C. 154](b)(1) are reduced as follows: (1) To the extent that there are multiple grounds for extending the term of a patent that may exist simultaneously (e.g., delay due to a secrecy order under [35 U.S.C.] 181 and administrative delay under [35 U.S.C.] 154(b)(1)(A)), the term should not be extended for each ground of delay but only for the actual number of days that the issuance of a patent was delayed; See 145 Cong. Rec. S14,718[3]

As such, the period for over 3 year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the date on which the application was filed overlap with the actual dates in the periods for failure of the Office to take action within specified time frames. In other words, consideration of the overlap does not begin three years after the filing date of the application.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap"

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[3] The AIPA is title IV of the Intellectual Property and Communications Omnibus Reform Act of 1999 (S. 1948), which was incorporated and enacted as law as part of Pub. L. 106-113. The Conference Report for H.R. 3194, 106th Cong. 1st Sess. (1999), which resulted in Pub. L. 106-113, does not contain any discussion (other than the incorporated language) of S. 1948. A section-by-section analysis of S. 1948, however, was printed in the Congressional Record at the request of Senator Lott, See 145 Cong. Rec. S14,708-26 (1999)(daily ed. Nov. 17, 1999).

under 35 U.S.C. 154(b)(2)(A) is the entire period during which the application was pending before the Office, November 21, 2003, as terminated by the filing of the RCE on February 7, 2008. 613 days of patent term adjustment were accorded prior to the issuance of the patent for the Office failing to respond within a specified time frame during the pendency of the application. All of the 443 days for Office delay in issuance of the patent, as terminated by the filing of an RCE, overlap with the 613 days of Office delay accorded prior to issuance of the patent. 613 days is determined to be the actual number days that the issuance of the patent was delayed, considering the 443 days over three years to the filing of the RCE.

Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment for the Office taking in excess of 3 years to issue the patent.

Patentees further assert that a period of reduction of patent term should be entered for the mailing of a notice of allowance on April 8, 2008, 62 days after the filing of a request for continued examination on February 7, 2008.

Patentees are incorrect. The filing of a request for continued examination after the mailing of a notice of allowance is not grounds for a reduction in patent term adjustment under 37 CFR 37 CFR 1.704(c)(10). As such, entry of a period of reduction of 62 days is not warranted.

In view thereof, no adjustment to the patent term will be made.

Telephone inquiries specific to this matter should be directed to Douglas I. Wood, Senior Petitions Attorney, at (571) 272-3231.

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